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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,806	06/23/2005	Antonella Giannini	U 015548-I	2949
140	7590	07/19/2007		
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER GEHMAN, BRYON P	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 07/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,806

Applicant(s)

GIANNINI ET AL.

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/21/04</u> | 6) <input type="checkbox"/> Other: _____ |

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1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be **material to patentability as defined in 37 CFR 1.56.**

2. Claim 1 is objected to because of the following informalities: In claim 1, line 9, the comma between "rear" and "end" is improper. Appropriate correction is required.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, line 7, "cup-shaped" is indefinite, as it is unclear what is encompassed by "cup-shaped" the parallelepiped shape shown does not distinguish a "cup-shape in normal description or understanding. In claim 1, lines 9-10, "the bottom wall (13) of the first container (3) comprises at least one through hole" is not disclosed by the specification and in fact contradicts the specification, where the disclosed through hole is in the bottom wall of the second container. The claims will

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be rejected in view of the actually disclosed structure, as opposed to what is claimed, which appears to be entirely inaccurate.

To any degree applicant may argue the claims accurately claim what was intended, the specification and Figures do not provide support for the invention as claimed and changing the specification and Figures to what appears have been an inaccurate description in the claims would comprise new matter.

As to claim 2, the subject matter, not shown by the drawings in any manner, is indefinite.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of claim and its dependent claims is indefinite, as it is indefinite whether "rigid carton of packets of cigarettes" defines the combination of a carton and packets of cigarettes, as if it does, in line 2, "packets (2) of cigarettes" should indicate its relationship to the previously defined "packets of cigarettes".

In claim 2, lines 2 and 3, the meaning of "respective" is indefinite, as there is no described relationship to distinguish "respective" to be related to.

In claim 5, the subject matter appears to be redundant in view of what has been properly disclosed.

In claim 6, the claim is indefinite, as parent claim 4 defines an end wall, then claim 6 attempts to eliminate it. This is improper claim form.

In claim 22, lines 2-3, the use of "and/or" (both instances) renders the claimed subject matter indefinite and the line should be --wherein at least one of the longitudinal edges and transverse edges of the first container and the second container is one of beveled or rounded.--.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1- 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Focke et al. (4,779,723). Disclosed is a rigid carton of packets of cigarettes, the carton comprising a first container (10), a second container (11) housing the first container in a sliding manner between a closed position and an open position, the first container comprising an open top end (see in Figure 2), a bottom wall (15), two opposite parallel lateral walls (36 and 36) and two opposite parallel front and rear end walls (22 and 23), the carton having the bottom wall of the second container comprising at least one through hole (open end of 10) sized to permit insertion of a finger.

As to claim 2, the through hole of Focke et al. is sized to permit insertion of a finger for each packet of cigarettes disclosed.

As to claim 3, Focke et al. disclose the second container comprising two parallel lateral walls (31 and 31) and opposite top and bottom walls (24 and 25).

As to claim 6, Focke et al. discloses the absence of an end wall. This rejection may be a *non sequitur*, but applicants' claim is a *non sequitur*.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5, 7-8, 11-18, 22-25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Militzer (6,491,212). In view of Bouchard (4,534,463). Militzer discloses a rigid carton capable of receiving packets of cigarettes, the carton comprising a first container (70), a second container (20) housing the first container in a sliding manner between a closed position and an open position, the first container comprising an open top end (at 21), a bottom wall (at 23), two opposite parallel lateral walls (43 and 53) and two opposite parallel front and rear end walls (at 22 and at 24), the second container having a bottom wall (at 74). Bouchard discloses a carton comprising a first container (14), a second container (12) housing the first container in a sliding manner between a closed position and an open position the carton having a bottom wall (24),

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opposite an open top (at 30) of the second container comprising at least one through hole (62) sized to permit insertion of a finger. To modify the carton of Militzer employing the finger hole teaching of Bouchard would have been obvious in order to facilitate sliding of the first container from the second container.

As to claim 2, the through hole of Bouchard. is sized to permit insertion of a finger for each packet of cigarettes disclosed.

As to claim 3, Militzer discloses the second container comprising two parallel lateral walls (between 71 and 73) and opposite top and bottom walls (71 and 73).

As to claim 4, Militzer discloses the second container as a tubular parallelepiped having one end closed by an end wall (at 74).

As to claim 5, such is explained above, as such is what is described in the specification and drawings.

As to claims 7 and 8, Bouchard discloses recesses (16) in each lateral wall, provided to allow gripping of the first container. The exact shape would appear to be a matter of design choice.

As to claims 11-15, Militzer discloses forming the containers from first and second blanks.

As to claims 16-18, in view that applicant has omitted such partitions from the drawings, it is held that to provide partitions in some manner would have been well within the level of ordinary skill so as to obviate any need for it being shown. Traversal of this holding will necessitate submission of drawings showing the partitions.

As to claims 22 and 23, to align the packets in the same disposition relative to each other within a carton is officially noted to be old and well-known, and the disposition of the packets would fail to distinguish any new or unexpected result.

As to claims 24 and 25, to provide curved portions of the containers would be a matter of design choice, and would provide no new and unobvious result and be obvious to one of ordinary skill in the art, as recognized and evidenced by their lack of representation in the drawings.

11. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 4 above, and further in view of Mahler (5,088,599). Mahler discloses engaging tongues to maintain a first container within a second container. To modify the prior art combination further employing the engaging tongue teaching of Mahler would have been obvious in order to maintain the containers together, as suggested by Mahler.

12. Claims 16-18 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of either one of Geraedts (4,185,763) and Rosen (3,489,272). Each discloses providing partitions in a carton to separate its contents. To modify either of the base prior art references employed against claim 1 above employing partitioning would have been obvious in order to order and separate the contents, as suggested by either one of Geraedts and Rosen.

13. Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Moore (2,541,173).

Moore discloses providing an overwrap on an inserted container. To modify either of the base prior art references employed against claim 1 above employing an inner overwrap would have been obvious in order to protect the contents from ambient conditions, as suggested by Moore.

14. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Roberts (3,083,820).

Roberts discloses providing an overwrap on a combination of an outer container and inserted container. To modify either of the base prior art references employed against claim 1 above employing an overwrap as shown by Roberts would have been obvious in order to protect the contents and outer container from ambient conditions, as suggested by Roberts.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are analogous sleeved containers or including finger holes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571)

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272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Bryon P. Gehman
Primary Examiner
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BPG